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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/820,812  | 03/30/2001  | David W. Cannell     | 05725.0783-00       | 5365             |
| 22852   | 7590        | 04/10/2006           | EXAMINER            |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | WANG, SHENGJUN      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1617                |                  |

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/820,812

Applicant(s)

CANNELL ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 22-63 and 70-100 is/are allowed.
- 6) ☒ Claim(s) 16-21, 64-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The terminal disclaimer filed on January 11, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patents 6,486,105; 6,800,302, and US application 09/820,934 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Response to the Arguments***

Applicants' amendments and remarks submitted April 27, 2005 have been fully considered, and found persuasive to overcome the rejections under 35 U.S.C. 103 over Karlen et al. and Bertho et al. Particularly, claims as amended, require the heating step be next in time, space or order of the application of the composition, or the heating step be in the same time with the application of the composition. As argued by applicants' the cited references do not teach a fairly suggest the method as herein claimed.

Applicants' remarks as to the construction of claims have been considered and persuasive. Particularly, as further defined in the claims, the "and then" are interpreted as read on both applied prior to said heating or during said heating.

In view of the terminal disclaimers, the elected species are allowable, and the claims now have been examined in the full scope.

#### ***Claims Objections***

2. Claims ~~16~~ 21, 64-69 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is noted that claims 1 and 49 clearly limit

the compounds as C3 to C5 monosaccharides substituted with at least one C1 to C22 carbone chain. Claims 15-21 and 64-69 further expand the scope of compounds to include derivatives of the compounds defined in claims 1 and 49 and do not further limit claims 1 and 49.

***Claim Rejections 35. U.S.C. 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims ~~16~~-21 and 64-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims ~~16~~-21, and 64-69 recites the limitation "derivative". There is insufficient antecedent basis for this limitation in the claim.

5. Claims ~~16~~-21, and 64-69 recites the limitation "derivative". However, the claims or the specification provide no clear definition for the "derivative." Furthermore, the claims are confusing as to the definition of "derivative." Particularly, claims 1 and 49 clearly limit the compounds as C3 to C5 *monosaccharides* substituted with at least one C1 to C22 carbone chain. Claims 19 and 67 further define the *monosaccharides* as *oligosaccharides*, which is conflict with art acceptable meaning of "*monosaccharides*."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG  
PRIMARY EXAMINER

Shengjun Wang  
Primary Examiner  
Art Unit 1617